Remarks

Claims 1-23 are currently pending in the application. Applicant has amended claims 1-14, 16-17, and 19-23. Claims 1-23 stand rejected. Entry of the Amendment and favorable consideration thereof is earnestly requested.

Examiner Interview

On April 12, 2005, Applicant's representative conducted an Interview of the Examiner. Applicant's representative discussed how the cited references failed to teach each limitation of the claims. The Examiner suggested clarification of the limitations and further structural limitations to be included in amended claims which should be filed with a Request for Continued Examination in the present application.

Rejection under §112

The Examiner has rejected claims 14 and 21 under 35 U.S.C. §112 second paragraph as indefinite for lack of antecedent basis. Applicant has amended claim 4, from which claim 21 depends, and amended claim 14 to provide proper antecedent basis for the claims.

Rejections under 102(b)

Claims 1, 8, 12, 13, 15, 16 and 23–Hay et al.

The Examiner has rejected claims 1, 8, 12, 13, 15, 16 and 23 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,834,371 to Hay et al.. Applicant respectfully disagrees for the following reasons.

With regard to claim 1, the Examiner cites Hay for disclosing a figure having a hole passing through a portion thereof. The Examiner asserts that while Applicant

previously argued that the hole of the claimed invention passes completely through, the claim does not require such. See Office Action, p.7. In response, Applicant has amended claims 1-3, 14, and 16-17 to clarify and recite the element of the hole "passing **completely** through a **body part**" of the doll. Applicant's hole passes completely through a body part of the doll, for example, the ear of the doll, as is supported by the specification and drawings. Specifically, Paragraphs 27 and 35 of the Application, state that "accessories such as jewelry, ribbons, or other material can be threaded or **passed through** holes in various body **parts** of the figure." Figures 2-5 show that the hole passes completely through the body part of the doll, the part shown specifically here to be the ear. Therefore, the accessory can pass all the way, completely through the hole.

In contrast "the hole in the support 9 or 10 of the piece 3" of Hay, as cited by the Examiner, does not pass completely through the part (support 9 or10) of the figure, and does not teach Applicants claim element of a doll having a hole disposed in a body part thereof. Hay et al. teaches the magnet of the piece is located "below or in" the support (feet) of the piece (col. 3, lines 18-19). What the Examiner has referenced as a "hole" is where the magnet 13 is located within (or received by) the support 9 or 10. While the "hole" in Hay, would be a recess but for the magnet 13 located therein, it clearly is not (and could never be) a hole passing completely through the support 9, as the magnet would be able to pass through the support and not be retained in the figure in Hay. As such, Hay does not disclose or suggest Applicant's claim element of a hole **passing completely through a body part** of the doll, nor the element of removably receiving an accessory **completely through the hole**. Nowhere in Hay et al. is there a teaching or suggestion to provide a **hole passing completely through** a **body part** of the doll for removably receiving an accessory as is required by Applicant's independent claims 1 and 2, and dependent claims 3-7, 16-17, 21-22 as currently amended, which include this element.

With regard to claim 8 (and claims 12-13, 15-16, 23, depending therefrom), the Examiner states that "[t]hough Hay does not disclose explicitly the magnet 'embedded completely' inside" (see Office Action, p. 7), its disclosure of a magnet 8 located in or below the support (col. 3, lines 18-19) "encompasses" the claim element of at least one ferrous portion embedded completely inside the figure. In response, Applicant amends this element of claim 8 to recite a ferrous portion **permanently** embedded completely **within an interior part of** said doll for clarification. Support for this amendment is found in Applicant's specification 37 and 38 and Figures 7 & 8. Figure 7 shows in ferrous portions 124, 126 embedded completely within a part of figure 100, specifically, ferrous portion 124 embedded within foot 108, and ferrous portion 126 embedded in shoe 118. (Paragraph 37 states: "Ferrous portion 124 is shown disposed in at least one foot 108 of figure 100. Ferrous portion 126 is shown disposed in at least one shoe 108 of figure 100 where shoe 108 may be permanently affixed or removably attached to foot 108.) As Figure 8 only shows the exterior of figure 100, embedded ferrous portions 124, 126 are not visible as they are **permanently embedded completely within an interior part** of the doll. As such, no surface of the magnet can make contact with anything exterior to the doll.

In contrast, Hay et al. teaches: "two supports 9 and 10 intended for *contact with* the game board 2, said supports being the feet of the figure....The magnet of the piece is located below or in the support 9." (Hay et al. col. 3, lines15-18) The magnet of Hay et al. is located at the foot of the piece, within a recess or "hole," so that it may *contact* the *exterior* (game board) and does not teach or suggest at least one ferrous portion embedded completely within an interior part of the doll. In fact Hay et al. teaches away from embedding a ferrous portion completely inside a doll as the magnet of Hay et al. is disclosed to be in the *external* to the support of the piece as it must contact the game board surface. Hay does not disclose, explicitly or implicitly, nor does its magnet 13 encompass Applicant's ferrous portion permanently embedded completely

within an interior part of the doll. For at least these reasons, Hay does not teach or suggest claim 8 as amended and any of its dependent claims, claims 9-20 and 23.

Claims 8, 13, 19 and 20 – Philippi

The Examiner has rejected claims 8, 13, 19 and 20 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 2,036,076 to Philippi. Applicant respectfully disagrees as Philippi, similarly to Hay, does not disclose the claim element of a ferrous portion **permanently** embedded completely within an interior part of the doll, as is required by independent claim 8 and all of its dependent claims, 9-20 and 23 as well as claims 4 and 21.

The Examiner cites col. 2, par. 7 and figure 8 of Phillipi, which discloses "the body having a lowerly disposed recess 32 for receiving and freely retaining a ball 33 or equivalently magnetic material, such as steel" (col. 7, lines 73-75). This description along with figure 8 show the magnetic material to be in a recess of the body with a portion external to the body and in contact with the surface 10 of the game. Phillipi does not disclose or suggest Applicant's ferrous portion permanently embedded completely within an interior part of the doll.

Further, Phillppi fails to teach or suggest Applicant's claim elements of: a **plush** doll; and a backing disposed on said side of said stage that receives said manipulator to retain said manipulator on said side of said stage, as is recited in amended claim 8.

For at least these reasons, Philippi does not teach or suggest claim 8 as amended and any of its dependent claims, claims 9-20 and 23, as well as claims 4 and 21.

Claims 8, 18 and 23 – Goldfarb and Knowles

The Examiner has rejected claims 8, 13, 19 and 20 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 3,946,520 to Goldfarb or U.S. Patent No. 2,814,909 to Knowles.

Applicant respectfully disagrees as neither Goldfarb or Knowles, similarly to Hay and Philippi, discloses the claim element of a ferrous portion permanently embedded completely within an interior part of the doll, as is required by independent claim 8 and all of its dependent claims, 9-20 and 23, as well as claims 4 and 21.

Goldfarb teaches a pair of magnets 44 mounted in plastic disc 42 at the base of the doll 30 (*see* Goldfarb col. 3, lines 39-41) and held within recesses formed in the *bottom wall* of the disc by adhesives or an otherwise snug-fitting engagement. (See Goldfarb col 3, lines 56-60). The arrangement in Goldfarb teaches magnets *exterior* to the doll, held out from recesses in the bottom wall of the disc to expose them to (and allow them to contact) the floorboard 12 of the doll house. Goldfarb does not teach or suggest at least one ferrous portion permanently embedded completely within an interior part of the doll, where contact with surfaces or objects external to the doll is precluded.

Knowles teaches a magnet 25 mounted in base 22 which is separate and distinct from (and exterior to) the doll 20. See col. 3, lines 57-60. Dolls 20 have sockets so that they may *removably* receive the magnet-containing base 22 and be interchanged on base units. See col. 3, line 72-col. 4, line 1. Knowles teaches a magnet permanently retained *exterior* to the doll and *removably* (rather than permanently) attached to the doll at time when the socket of the doll is placed on base unit. Clearly, Knowles does not disclose at least one ferrous portion **permanently** embedded completely within an **interior part of the doll**, an element of claim 8 and all of its dependent claims as well

as claims 4 and 21. In fact, Knowles, disclosing a magnet which is exterior to and removable from the doll, teaches away from the present claims.

Further, neither Goldfarb nor Knowles teaches or suggests Applicant's claim elements of: a **plush** doll; and of a backing disposed on said side of said stage that receives the manipulator to retain the manipulator on said side of said stage, as is recited in amended claim 8.

For at least these reasons, claim 8 and all of its dependent claims, including claims 18, 19 and 23 as asserted in the Examiner's rejection, as well as claim 4 and 21, are patentable over Goldfarb or Knowles.

Rejections under 103(a)

Claim 2, 4 and 21 – 103(a) Parson in view of Woolington

The Examiner has rejected claims 2, 4 and 21 under 35 U.S.C. §103(a) as unpatentable over Parsons in view of Woolington. As amended herein, claims 2, 4 and 21 all include the element of a hole **passing completely through** a body part of the doll for removably receiving an accessory completely through the hole, and claims 4 and 21 further includes the element of at least one ferrous portion permanently embedded completely within an interior part of said doll.

There is no disclosure found in Parsons or in Woolington of such a hole passing completely through a body part of the doll. Further, while Parsons includes pieces of ferrous metals in the hands of the doll, these ferrous metals are "exposed" to allow "direct contact [of metal objects] with the *exposed surface* of the magnet." See Parsons col. 1, lines 35-36. Parsons states that "it is desirable that the surface of the magnet shall be arranged in such a manner as to contact as directly as possible with

the metals to be attracted and held thereby." (Parsons col. 2, lines 43-47.) As such, Parsons teaches away from a ferrous portion permanently embedded completely within an **interior** part of said doll. Woolington, a motorized talking doll, does not mention magnets and cannot remedy the defects in the teachings of Parsons. Neither Parsons nor Woolington, alone and/or in combination disclose or suggest all elements of claims 2, 4 and 21 and do not render the present claims obvious.

Claims 2, 3 and 5-7 – 103(a) Unalp in view of Ware

The Examiner has rejected claims 2, 3 and 5-7 as unpatentable over Unalp in view of Ware. Specifically, the Examiner cites Unalp for teaching all claim elements except for a plush teddy bear figure. Applicant respectfully disagrees. Unalp discloses a doll with a concealed sticker dispenser and a plurality of cooperating stamp elements. (See Unalp, col. 8, lines 50-51) The doll has "an ear 17 having a aperture 18 formed in the earlobe therof." (See Unalp, col. 3, lines 9-10), which is described as follows: "Earring 30 further includes a resilient embossed stamp 33 supported upon base 31 and closure cap 34 which is removably securable to embossed stamp 33 and base 31. (See Unalp. Col. 3, lines 14-21) Unalp states that the post 32 of an earring is receivable *within* aperture 18. (See Unalp col. 3, lines 16-17) . The aperture is not disclosed as passing **completely** through the ear of the doll, nor is it stated that the earring could go *completely through* the aperture or *through* the ear of the doll. Unalp discloses earring being "supported *upon*" the ear. See col. 4, lines 23-24. Therefore, while the disclosure in Unalp includes an aperture in the ear, it does not disclose the element of a hole **passing completely through** a body part of the doll for removably receiving an accessory **completely through** the hole, as recited in independent claim 2 and all of its dependent claims, including 3, and 5-7.

The Examiner cites the Ware reference as disclosing a figure in the form of a plush teddy bear, it cannot remedy the deficiencies in Unalp in falling to disclose. Further there is no suggestion in combining the two references. The doll in Unalp has a torso with planar support members, a hollow torso cavity with dispensing frame (for supporting a sticker dispensing mechanism therein which cooperates with movement of doll) and pivoting appendages with gears. See col. 4, lines 40-43; col.5, lines 2-9 and 16; col. 6, lines 3-6). In achieving and support this, the doll in Unalp would require construction using a rigid, non-plush material. There is no suggestion to combine this with a plush teddy bear of Ware, as is suggested by the Examiner. Further, such a combination would likely render an inoperable doll, as a stuffed plush construction could not support the mechanism in Ware, teaching away from their combination . For at least these reasons, claims 2, 4 and 21 are patentable over Unalp alone and/or in combination of Ware.

Claims 10 and 11 – 103(a) Goldfarb in view of Blaustein et al.

The Examiner has rejected claim 10 and 11 under 35 U.S.C. §103 (a) as unpatentable over Goldfarb in view of Blaustein. Applicant respectfully disagrees.

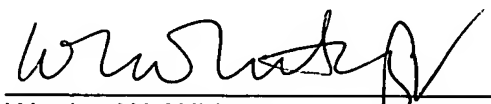
As previously discussed, Goldfarb teaches magnets, held out from recesses in the bottom wall of the disc to expose them to (and allow them to contact) the floorboard 12 of the doll house, and hence exposure that is *exterior* to the doll. Goldfarb does not teach or suggest at least one ferrous portion permanently embedded completely within an interior part of the doll, where contact with surfaces or objects external to the doll is precluded, as in claims 10 and 11. Blaustein is cited for teaching a cat plush figure and cannot remedy the defects in Goldfard to render the claims obvious.

Claims 14 – 103(a) Hay

The Examiner has rejected claim 14 as unpatentable over Hay, stating that Hay teaches most of the claimed elements except for the shoes removably attached to each foot, which the Examiner asserts is a modification that would be obvious to one of skill in the art. As previously discusses, Hay et al. discloses: "two supports 9 and 10 intended for *contact with* the game board 2, said supports being the feet of the figure....The magnet of the piece is located below or in the support 9." (Hay et al. col. 3, lines15-18) The magnet of Hay et al. is located at the foot of the piece, within a recess or "hole," so that it may *contact* the *exterior* (game board) and does not teach or suggest at least one ferrous portion embedded completely within an interior part of at least one of the shoes (removably attached to the doll), as is claimed in Applicant's claim 14.

The aforementioned amendments and remarks show claims 1-23 to be patentable over the references cited by the Examiner, and all rejections are respectfully traversed. It is respectfully submitted that all of the claims in the application are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,



Wesley W. Whitmyer, Jr., Registration No. 33,558
Helen M. Limoncelli, Registration No. 51,950
Attorneys for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155